

Express Mail No. EL 998649035 US

REMARKS

Upon entry of this Amendment A, claims 92 and 165-195 are currently pending and under consideration. Claims 1-91 and 93-164 are cancelled by this amendment; in canceling this subject matter from this application, applicants expressly reserve the right to pursue the remaining subject matter through one or more continuation applications.

New claims 165-195 are supported in the specification. In particular, support for claims 165-167, 173-175 and 181-183 can be found, for example, in the claims as originally presented (see, *i.e.*, claim 93) and at page 4, lines 20-25 of the specification. Further support can be found in the definition of "heterocyclo" found at page 20, lines 23-34 of the specification. Support for claims 168, 169, 176, 177, 184 and 185 can be found, for example, in the claims as originally presented (see, *i.e.*, claim 94) and at page 4, line 26 to page 5, line 2 of the specification. Further support for claims 168, 169, 176, 177, 184 and 185 can be found in the series of compounds recited in Example 5. Support for claims 170, 178, and 186 can be found, for example, at page 4, lines 1-3. Support for claims 171, 179, and 187 can be found, for example, at page 4, lines 1 and 7. Support for claims 188-190 may be found, for example, at page 10, line 13 to page 11, line 21. Support for claim 191 may be found, for example, at page 16, line 33 to page 17, line 35. Support for claims 192-195 can be found in the compounds exemplified in Examples 2 and 3.

I. Rejection Based on 35 USC §112, Second Paragraph

Reconsideration is requested of the rejection of claims 3, 7, 11, 15, 19, 23, 27, 31, 35, 39, 43, 47, 51, 55, 59, 63, 67, 71, 75, 79, 83, 87, 94, 106, 131-133, 135-137, 146-148, 150-152, 156-158, and 160-162 under 35 USC §112, second paragraph for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the above claims are said to lack antecedent basis because X_3 can not embrace C₁ alkyl. All of the above claims have been canceled thus rendering moot this rejection.

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II. Rejections Based on 35 USC §102(e)

Reconsideration is requested of the rejection of claims 1-87, 92-95, 97-98, 100-108, 110-111, 113-117, 125-126, 130-137, 141-143, 145-153, and 155-163 under 35 USC §102(e) as being anticipated by formula (I) in column 3 of Ojima (US 6,100,411). All of the above claims have been canceled by this amendment except claim 92. As amended, claim 92 requires that the C3' substituent (designated as X₃ in the present application) be heterocyclo. The compounds defined by formula (I) of Ojima, however, do not meet this requirement; instead, the C3' substituents of formula (I) are restricted to C₃-C₅ alkyl or alkenyl or trifluoromethyl.

The new claims added by this amendment are also distinguishable from the compounds of formula (I) of Ojima. Specifically, claim 172 requires the C9 substituent (designated as R₉ in the present application) be hydroxy or acyloxy; the C9 substituent of Ojima's formula (I) is keto. Similarly, claim 180 requires the C14 substituent (designated as R₁₄ in the present application) be hydroxy whereas the C14 substituent of Ojima's formula (I) is hydrogen.

III. Rejection Based on Nonstatutory Double Patenting

The Office has rejected claims 1-164 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 131 of U.S. Patent No. 6,596,737. Applicants will determine the propriety of filing a terminal disclaimer with respect to this reference once all other rejections have been resolved.

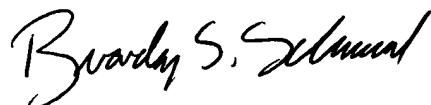
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CONCLUSION

In light of the foregoing, applicants request entry of the claim amendments and new claims, withdrawal of all claim rejections, and solicit an allowance of the claims. The Examiner is invited to contact the undersigned attorney should any issue remain unresolved.

The Commissioner is hereby authorized to charge any under payment or credit any over payment to Deposit Account No. 19-1345.

Respectfully submitted,



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